REMARKS

With the foregoing amendment claims 1-17 and 19-21 are pending in the application. Claims 1, 9, and 20 are independent. No new matter has been added by the amendments. Applicants respectfully request reconsideration of the present application.

I.   First Claim Rejection(s) Under 35 U.S.C. 103

Claims 1-8 stand rejected under 35 U.S.C. 103 as being unpatentable over Tsai (US 6,839,741) in view of Freed (US 2003/0055903). Applicants respectfully traverse.

Claim 1 is directed to an e-mail system that notifies an intended recipient of the existence of information that was transmitted to the intended recipient but never received by the recipient because the information was bounced by the intended recipient's e-mail server.

Claim 1 is patentable over Tsai in view of Freed because neither Tsai nor Freed, considered alone or in combination, teach or suggest all of the features of claim 1. For example, at the least, neither Tsai nor Freed, considered alone or in combination, teach or suggest an e-mail system that "examines a received e-mail message to determine whether a previous e-mail message was not received by an intended recipient of the previous e-mail message, and ... posts at least a portion of said previous e-mail message to [an] undelivered data storage ... and sends a notification ... to the intended recipient notifying the intended recipient of the existence of the previous e-mail message, wherein the notification e-mail includes instructions instructing said intended recipient as to how to retrieve said least a portion of said previous e-mail message," as is recited in claim 1.

Tsai is directed to a method of sending a file to a recipient. Conventionally, most people send a file to a recipient by attaching the file to an e-mail message and then sending the e-mail message together with the attached file to the recipient. Tsai discloses that it would be better if the file attached to e-mail message was not transmitted to the recipient together with the e-mail message, but rather posted to an attachment server, thereby enabling the recipient to download the file from the attachment server whenever it is convenient for the recipient. For example, at column 3, lines 14-24, Tsai states,

> In a first alternate implementation, a sender of an email posts an attachment on the server and sends the textual portion of the email onto the recipients. In a second alternate implementation, the sender sends the email with the attachment towards the recipients. An attachment server receives the email and strips the attachment from the email. The textual portion of the email is sent onto the recipients and the recipients are notified that the attachment has been removed. The attachment is stored at the attachment server for access by the recipients.

Accordingly, Tsai discloses posting an attachment to an attachment server. However, Tsai does not disclose a system that "[1] posts at least a portion of [a] previous e-mail message to [an] undelivered data storage ... and [2] sends a notification ... to the intended recipient notifying the intended recipient of the existence of the previous e-mail message," as is required by claim 1. Moreover, Tsai does not suggest posting to a data storage at least a portion of a previous e-mail message that was not received by an intended recipient because Tsai never mentions an e-mail messages or other message that was never received by an intended recipient. Furthermore, as the Examiner correctly noted, Tsai does not teach or suggest an e-mail system that "examines a received e-mail message to determine whether a previous e-mail message was not received by an intended recipient of the previous e-mail message," as is also required by claim 1.

Freed does not make up for the deficient teachings of Tsai because Freed does not teach or suggest a system that: (1) "posts at least a portion of [a] previous e-mail message to [an] undelivered data storage ... and sends a notification ... to the intended recipient notifying the intended recipient of the existence of the previous e-mail message," and (2) "examines a received e-mail message to determine whether a previous e-mail message was not received by an intended recipient of the previous e-mail message."

Freed discloses a system for reducing unintended duplication of messages. See Freed, para. 0011 ("The present invention is directed to a system and method for a sending e-mail server to reduce the unintended duplication of messages"). To reduce unintended duplication of messages, Freed discloses a method that includes the following steps: receiving a first message; forming a first hash value based on the first message; receiving a

second message; forming a second hash value based on the second message; comparing the first hash value to the second hash value; and determining that the second message is an unintended duplicate of the first message if the first hash value matches the second hash value.

Accordingly, Freed has nothing whatsoever to do with bounced messages (i.e., sent messages that were not received by the intended recipient). That is, Freed does not teach or suggest a system or method for dealing with bounced messages. Thus, Freed does not teach or suggest, for example, a system that "examines a received e-mail message to determine whether a previous e-mail message was not received by an intended recipient of the previous e-mail message." Therefore, Freed does not make up for the deficient teachings of Tsai.

Because neither Tsai nor Freed, considered alone or in combination, teach or suggest all of the features of claim 1, Applicant respectfully requests that the rejection of claim 1, and claims 2-8, which depend from claim 1, be withdrawn.

II.   Second Claim Rejection(s) Under 35 U.S.C. 103

Claims 9-15 stand rejected under 35 U.S.C. 103 as being unpatentable over Tsai in view of Schneider (US 2002/0010745). Applicants respectfully traverse.

Like claim 1, claim 9 covers a method for notifying an intended recipient of the existence of information that was transmitted to the intended recipient but never received by the recipient because the information was bounced by the intended recipient's e-mail server.

Claim 9 is patentable over Tsai in view of Schneider because neither Tsai nor Schneider, considered alone or in combination, teach or suggest all of the features of claim 1. For example, at the least, neither Tsai nor Schneider, considered alone or in combination, teach or suggest a method that includes: "determining if the size of the first e-mail message exceeds a size limit, wherein the determination is based, at least in part, on information included in the second e-mail message," as is recited in claim 9. As another example, neither Tsai nor Schneider, considered alone or in combination, teach or suggest, "posting at least a portion of said first e-mail message to a server accessible to the intended recipient in response to a determination that the size of the first e-mail message exceeds a size limit," as is also recited in claim 9.

As discussed above, Tsai is directed to a method of sending a file to a recipient. The method includes the steps of: (1) uploading the file to a web server and (2) sending a text only e-mail message to the intended recipient of the file so that the intended recipient can log onto the web server and download the file. Nowhere does Tsai teach or suggest "determining if the size of [a] first e-mail message exceeds a size limit, wherein the determination is based, at least in part, on information included in [a] second e-mail message," or "posting at least a portion of said first e-mail message to a server accessible to the intended recipient in response to a determination that the size of the first e-mail message exceeds a size limit." Accordingly, Tsai does not teach or suggest all of the features of claim 9.

Schneider does not make up for the deficient teachings of Tsai. Schneider discloses a system that "[detects] when a message is bounced or undeliverable." Para. 0015. When the system detects that a message is bounced, the system "generates URI having a query portion that uses the e-mail address or contact information of the intended recipient as a search request to retrieve more contact information." Id. The generated URI is then sent to the sender of the message that was bounced. The sender may use the received URI to obtain information about the intended recipient.

Although Schneider discloses determining if a message has been bounced, Schneider does not teach or suggest determining whether the bounced message exceeds a size limit. That is, determining whether a message has been bounced is not the same as determining whether a message exceeds a size limit. There are many reasons why a message may be bounced. For example, an e-mail message may be bounced if the e-mail address in the "To" field of the e-mail message is invalid. As another example, an e-mail message may be bounced if the e-mail address in the "From" field of the e-mail message is included on a "do not accept" list maintained by the intended recipient of the e-mail message. An intended recipient may have many e-mail addresses on a "do not accept list" because the intended recipient may not want to receive unsolicited e-mail. Accordingly, detecting whether a message has been bounced is not the same as determining whether the message has exceeded a size limit. Thus, Schneider does not teach or suggest "determining if the size of [a] first e-mail message exceeds a size limit, wherein the determination is based, at least in

part, on information included in [a] second e-mail message," or "posting at least a portion of said first e-mail message to a server accessible to the intended recipient in response to a determination that the size of the first e-mail message exceeds a size limit." Accordingly, Schneider does not make up for the deficient teachings of Tsai.

Because neither Tsai nor Schneider, considered alone or in combination, teach or suggest all of the features of claim 9, Applicant respectfully requests that the rejection of claim 9, and claims 10-17 and 19, which depend from claim 9, be withdrawn.

III.   Third Claim Rejection(s) Under 35 U.S.C. 103

Claims 16-19 stand rejected under 35 U.S.C. 103 as being unpatentable over Tsai in view of Freed and Schneider. Applicants respectfully traverse. Claims 16-19 depend from claim 9. Accordingly, claims 16-19 are patentable for at least the reasons give above with respect to claim 9.

IV.   New Claims

New claims 20-21 are added. Applicant submits that claims 20-21 are patentable over the art of record. That is, none of the art of record teach or suggest all of the features of claims 20-21. For example, as discussed above, none of the art, considered alone or in combination teach or suggest "determining whether [a] message indicates that the size of the first e-mail message exceeds a size limit," as is required by claims 20-21.

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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